



AF 3731

PATENT
Atty. Docket No. 2620 (203-2764)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Timothy Wells, et al.

EXAMINER: Jessica R. Baxter

SERIAL NO.: 09/865,774

GROUP ART UNIT: 3731

FILED: May 25, 2001

DATED: February 2, 2004

FOR: **TROCAR ASSEMBLY WITH CUSHIONED ACTIVATOR**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop: Appeal Brief - Patents

RECEIVED
FEB 10 2004
TECHNOLOGY CENTER R3700

REPLY BRIEF

Sir:

In response to the Examiner's Answer mailed December 1, 2003, please consider the following remarks.

REMARKS

On page 5 of the Examiner's Answer, the Examiner states the following:

Applicant argues 'The cushioned member of Claim 1 differs greatly from the safety shield features of the Ott patent, which cover the sharpened tip of the obturator.' It is unclear how this argument is relevant.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 2, 2004.

Dated: February 2, 2004

Christopher G. Trainor
Christopher G. Trainor

The recitation of the features of the Ott patent was provided to illustrate the fact that the Ott patent and the present invention are directed to two entirely different aspects of a trocar assembly. As discussed in further detail in the Appeal Brief, the Ott patent is directed to a trocar device with a shield for the cutting tip. In contrast thereto, the present invention is directed to a cushioned member which lessens the impact on a surgeon's hand during operation of the surgical instrument. As admitted by the Examiner, Ott does not disclose a cushioned member positioned on at least one contact surface of the hand grip. (See Examiner's Answer at page 3).

Furthermore, as discussed in the Appeal Brief, the recitation of the features of the Ott patent, as well as the features of the Silber patent, illustrates the fact that these two patents have opposing goals and, therefore, there is no suggestion or incentive to combine these two patents.

Continuing on page 5 of the Examiner's Answer, the Examiner attempts to define the term "cushioning" as "something resilient", in accordance with extrinsic evidence uncovered by the Examiner. More specifically, the Examiner argues that since the coating of Silber may be formed of an elastomeric material, it must, by definition, be resilient. The Examiner reaches even further by arguing that if the coating of Silber is formed of an elastomeric material, and if that elastomeric material is resilient, then the coating "must inherently provide a cushioning effect."

As discussed in the Appeal Brief, although Silber does disclose that the grip coating layer is preferably a low durometer thermoplastic elastomer (column 3, lines 63-64), Silber immediately precedes that statement with the following:

More specifically, the reduced control-pressure grip layer is

preferably a substantially thin, **rigid** elastomeric coating having a high coefficient of friction, a high chemical resistance, good cut resistance, and excellent adhesion to the underlying probe housing (emphasis added).

Taking these statements together, as they must be taken, Silber provides a substantially non-compressible, thin, **rigid** coating of a low durometer thermoplastic elastomer as a grip coating layer. Given these parameters, the coating layer of Silber could not provide a cushioning effect, even if it were formed of a low durometer thermoplastic material. Therefore, Silber's coating layer can not constitute a "cushioned member" as recited in Claim 1. If one were to attempt to modify Ott in view of Silber, as suggested by the Examiner, the resulting modified device would have a thin, rigid, non-compressible coating layer over a handle. Such a coating layer would not lessen the impact on a surgeon's hand while inserting a trocar through a patient's tissue. To infer that Silber's coating layer has an inherent "cushioning member", it must be clear that the missing descriptive matter is necessarily present in the provided description. Silber entirely lacks descriptive matter on a cushioning member for a hand grip.

Despite the Examiner's contention that Silber's coating may be defined as resilient, and therefore have cushioning features, the specification of Silber does not support this position. More specifically, the term "rigid", which is used in the Silber specification to describe the coating, is actually an antonym for the term "resilient", which is the term that the Examiner desires to use to describe the coating in Silber. Accordingly, Silber deliberately teaches away by providing a thin, **rigid** coating.

Lastly, the Examiner acknowledges the fact that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner then offers the following conclusory statement:

In this case, the Silber reference provides motivation to apply the Silber coating to the trocar of Ott in order to enable the instrument's user to maintain control of the instrument while applying minimal gripping force.

However, the Examiner fails to cite a specific example wherein Silber provides the necessary teaching, suggestion, or motivation to combine the references. There exists no motivation or incentive to attempt to combine the two references as one. Such an attempt is done in hindsight erroneously.

In view of the foregoing remarks and those included in the Brief on Appeal filed September 3, 2003, Appellants respectfully submit that all of the claims now pending in this application, namely Claims 1-10, are in condition for allowance. Early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road
Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

CGT/JML:sf